



PAUL D. HEYDON • PATENT ATTORNEY

6102 BROADWAY • SUITE B-2
SAN ANTONIO, TEXAS 78209
210 • 930 • 4300
210 • 804 • 1298 FAX

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Paul D. Heydon
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RE: Docket No. AT9-98-146. Application No. 09/439,052. Art Unit 2177.
Filing Date 11/12/1999. Examiner: Wong, Leslie.

Sir:

Transmitted herewith for filing is correspondence regarding the application of:
Inventors: Kelvin Roderick Lawrence, et al.

For: A System and Method for Bookmark Set Search and Execution Refinement

Enclosed is:

X Brief on Appeal (3 copies).

The fee for this Brief on Appeal (37 CFR 1.17(c)) is: \$320.

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Respectfully submitted,

Paul D. Heydon

Paul D. Heydon

Reg. No. 46,769

Applicant : Lawrence et al.

Appl. No. : 09/439,052

Filed : 11/12/ 1999

Title : A System and Method for Bookmark Set Search

And Execution Refinement

Grp./A.U. : 2177

Examiner : Wong, Leslie

Docket No. : AT9-98-146



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BRIEF ON APPEAL

Sir:

Real Party in Interest

The real party in interest in the present appeal is International Business Machines Corporation, the assignee, as evidenced by the assignment set forth at reel 010407, frame 0314.

Related Appeals and Interferences

None.

Brief on Appeal - Appl. No. 09/439,052 - Page 1

09/19/2002 RUHTE1 00000003 090447 09439052
S.E. Ref: 00000003 DAH: 090447 09439052
01 FC:120 320.00 CH

Status of Claims

Claims 1 -21 have been canceled. New claims 22 - 24 have been added and stand finally rejected by the examiner. Claims 22 - 24 are the claims on appeal.

Status of Amendments

No amendments were filed subsequent to final rejection.

Summary of Invention

The present invention relates to information retrieval. The specification points out a problem: "the formation of a search argument is a difficult task for many users." Page 3, lines 26 - 27. The specification describes a user reading a useful document obtained in a search, and wishing "that he could have more documents like this...." Page 4, lines 5 - 7. As a solution to the above - mentioned problem, it would be desirable to provide the user with more documents like the useful document, by quickly refining a search "with a minimum of manual search formulation," as the specification points out at page 4, lines 12 - 14.

A solution to the above - mentioned problem, found in Claim 22 for example, comprises:

(a) marking URL's [Uniform Resource Locators] positive or negative regarding whether a user's needs are met by search results, while URL's remaining unmarked are neutral. See FIG. 3, reference numbers 302 - 304, and specification page 8, lines 17 - 23.

(b) creating a bookmark set which includes said marked URL's and said positive or negative markings. See FIG. 3, reference number 305, and specification page 8, lines 24 - 26.

(c) submitting said bookmark set to a search engine. See FIG. 3, reference number 306, and specification page 8, lines 27 - 28.

(d) repeating (a) - (c) as often as said user desires, to refine said search results to a manageable level. See FIG. 3, reference number 308, and specification page 8, line 33 - page 9, lines 1 - 2.

Marking URL's and submitting them to a search engine, rather than editing and submitting words or phrases, shelters the user from details of query language.

Issues

Are Claims 22 - 24 patentable under 35 USC 103, over Ballard (U.S. Patent 5,987,457) in view of Takano and Winograd ("Dynamic Bookmarks for the WWW"), and further in view of Sciammarella (U.S. Patent 5,886,698)?

Grouping of Claims

Claims 23 - 24 are not separately argued.

Argument

A. Separate Argument for Claim 22

Errors in Rejection

The assignee respectfully asserts that it was erroneous to reject Claims 22 - 24, under 35 USC 103, over Ballard (U.S. Patent 5,987,457) in view of Takano and Winograd ("Dynamic Bookmarks for the WWW"), and further in view of Sciammarella (U.S. Patent 5,886,698).

This is the only ground for rejection contained in the final rejection. "All rejections previously made and not continued in the final rejection are considered as withdrawn." *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986)(quoting MPEP 707.07(e) and *Ex parte Martin*, 104 USPQ 124, 128 (Supr. Exmr. 1952)), *cert. denied*, 480 U.S. 933, 107 S.Ct. 1573 (1987). In the present case, the other objections and rejections previously made in the first office action were not continued in the final rejection, so presumably the earlier ones are withdrawn.

Differences Between the References, and the Claimed Invention as a Whole

As quoted in MPEP 2141.02, a "patentable invention may lie in the discovery of the source of a problem This is *part* of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103." *In re Spinnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (C.C.P.A. 1969). The present invention's specification points out that "the formation of a search argument is a difficult task for many users." Page 3, lines 26 - 27. Here is the source of a problem; the

cited references do not identify the problem. On the contrary, the Ballard '457 patent involves a refined query phrase that is displayed to the user for editing (Column 6, Lines 50 -56). The Sciammarella '698 patent requires the user to enter one or more key words (Column 6, Line 28). This should be considered as evidence of non-obviousness.

Limitations in the Rejected Claims Which Are Not Described in the References Relied On:

As stated in MPEP 2143 and 2143.03, a requirement for establishing a prima facie case of obviousness is that the reference or references must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

One limitation in the rejected claims, regarding user input, is "marking URL's positive or negative regarding whether a user's needs are met by search results." The specification at page 4 speaks of a user reading a useful document obtained in a search, wishing "that he could have more documents like this," and quickly refining a search "with a minimum of manual search formulation...." Consider marking URL's as a form of user input that minimizes manual search formulation. "Marking URL's" is distinct from Ballard's "categorizing at least one document," (Column 6, Lines 41 - 45) or Ballard's "mark[ing] at least one document," (Column 2, Lines 38 - 39). URL's are not mentioned by Ballard. The Sciammarella '698 patent requires the user to enter one or more key words as input (Column 6, Line 28); marking URL's is not described. Takano

and Winograd do not describe a positive or negative marking, and do not describe input regarding whether a user's needs are met by search results.

Another limitation in the rejected claims, not described by any of the references, is submitting a "bookmark set" (which includes said marked URL's and said positive or negative markings) to a search engine. A user may submit a "bookmark set" rather than submitting a refined query phrase to a search engine, for example. Consider submitting a set of URL's to a search engine as a way of asking: "Find more documents like these," while the user is sheltered from details of query language.

Another limitation in the rejected claims is "repeating (a) - (c) as often as said user desires, to refine said search results to a manageable level." The final rejection, Paragraph 4(d), admits that Ballard does not explicitly teach repeating as often as a user desires, to refine search results to a manageable level. The repetition of operations (a) - (c) is not described in the other references, either.

Why the References, Taken as a Whole, Do Not Suggest the Claimed Subject Matter:

The cited references do not suggest a solution that shelters a user from details of query language. On the contrary, the Ballard '457 patent involves a refined query phrase that is displayed to the user for editing, then submitted to a search engine (Column 6, Lines 50 -56). The Sciammarella '698 patent requires the user to enter one or more key

words (Column 6, Line 28).

These references, with their teachings regarding use of query phrases or key words, actually would lead away from the claimed invention.

The references do not teach or suggest all the claim limitations. Thus a prima facie case of obviousness has not been established.

Why Features Disclosed in One Reference May Not Properly Be Combined with Features Disclosed in Another Reference:

As stated in MPEP 2143 and 2143.01, a requirement for establishing a prima facie case of obviousness is that there must be some suggestion or motivation to combine reference teachings. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.... It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art" *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

The final rejection, Paragraph 4(d), admits that Ballard does not explicitly teach repeating as often as a user desires, to refine search results to a manageable level.

Sciammarella does teach repeating, according to the final rejection, Paragraph 4(d), which pieces together teachings of Ballard and Sciammarella. However, nothing in Ballard suggests refinement by repeating a set of operations as often as a user desires. Thus the combination is impermissible.

The final rejection, Paragraph 4(a), pieces together features of Ballard's, along with Takano and Winograd's use of URL's. However, Ballard does not suggest the desirability of Takano and Winograd's use of URL's. URL's are not mentioned by Ballard. Thus the combination is impermissible.

The references do not contain a suggestion or motivation to combine reference teachings. Thus a prima facie case of obviousness has not been established.

B. Claims 23 - 24 are not separately argued.

Conclusion

For the reasons advanced above, Assignee respectfully contends that each claim is patentable, and requests the reversal of all rejections.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul D. Heydon", with a stylized flourish at the end.

Paul D. Heydon
Attorney for Assignee
Reg. No. 46,769
6102 Broadway, Suite B2
San Antonio, TX 78209
(210) 930-4300

Appendix

Claims 22 - 24 are the claims on appeal.

22. A computer based method for search refinements, said method comprising:

- (a) marking URL's positive or negative regarding whether a user's needs are met by search results, while URL's remaining unmarked are neutral;
- (b) creating a bookmark set which includes said marked URL's and said positive or negative markings;
- (c) submitting said bookmark set to a search engine; and
- (d) repeating (a) - (c) as often as said user desires, to refine said search results to a manageable level.

23. A system for search refinements, said system comprising:

- (a) means for marking URL's positive or negative regarding whether a user's needs are met by search results, while URL's remaining unmarked are neutral;
- (b) means for creating a bookmark set which includes said marked URL's and said positive or negative markings;
- (c) means for submitting said bookmark set to a search engine; and
- (d) means for repeating (a) - (c) as often as said user desires, to refine said search results to a manageable level.

24. A computer-usable medium having computer-executable instructions for search refinements, said computer-executable instructions comprising:

(a) means for marking URL's positive or negative regarding whether a user's needs are met by search results, while URL's remaining unmarked are neutral;

(b) means for creating a bookmark set which includes said marked URL's and said positive or negative markings;

(c) means for submitting said bookmark set to a search engine; and

(d) means for repeating (a) - (c) as often as said user desires, to refine said search results to a manageable level.